



AF/IFW

Patent
Attorney's Docket No. 016660-181

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Wai Hing Lai et al.) Group Art Unit: 3742
Application No.: 10/693,938) Examiner: John A. Jeffery
Filed: October 28, 2003) Confirmation No.: 4311
For: ELECTRIC GRILL)
)
)
)
)

**REQUEST FOR WITHDRAWAL OF THE
FINALITY OF THE OFFICE ACTION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the finality of the Office Action dated November 16, 2004 be withdrawn, as premature.

In the Amendment filed September 22, 2004, original claim 11 was rewritten in independent form, by incorporating the subject matter of original claim 1. The rewriting of claim 11 in independent form did not present any substantive issues that were not previously before the Examiner at the time of the initial examination of the application.

In the most recent Office Action dated November 16, 2004, claims 11 and 12 were rejected on a new ground of rejection, that is based upon a newly-cited reference, Wertheimer et al. U.S. Patent No. 3,714,885. The Office Action was made final, on the grounds that "Applicant's amendment necessitated the new ground(s) of rejection presented in [the] Office action."

MPEP §706.07(a) states: "second or any subsequent actions on the merits shall be final except where the Examiner introduces a new ground of rejection *not necessitated by amendment of the application by Applicant ...*" (emphasis added). This section goes on to state that a second or subsequent action on the merits "will not be made final if it includes a rejection, on newly cited art,...of any claim not amended by Applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art."

There has been no showing that the rewriting of claim 11 in independent form "necessitated" the new ground of rejection based upon the Wertheimer patent. The presentation of claim 11 in independent form does not raise any new issues that were not before the Examiner at the time of the first Office Action. Hence, if claims 11 and 12 are properly rejectable on the basis of the Wertheimer patent, such a rejection should have been set forth in the first Office Action. The failure to do so precludes the current Office Action from being made final.

Accordingly, Applicants respectfully request that the finality of the Office Action dated November 19, 2004 be withdrawn as premature.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 9, 2004
By: 

James A. LaBarre
Registration No. 28,632

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620